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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,664	03/12/2001	Jill E. Barad	MAT 3C7B	2442
23581	7590	02/09/2005		
KOLISCH HARTWELL, P.C. 520 S.W. YAMHILL STREET SUITE 200 PORTLAND, OR 97204			EXAMINER CEGIELNIK, URSZULA M	
			ART UNIT 3714	PAPER NUMBER

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,664

Applicant(s)

BARAD ET AL.

Examiner

Urszula M Cegielnik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 13, 20-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6, 13, 20-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites in the last line, "the aperture (window opening 12) is smaller than the printed material". It is not clear what the scope of the claimed subject matter is. Is not clear how the aperture can be smaller than the printed material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

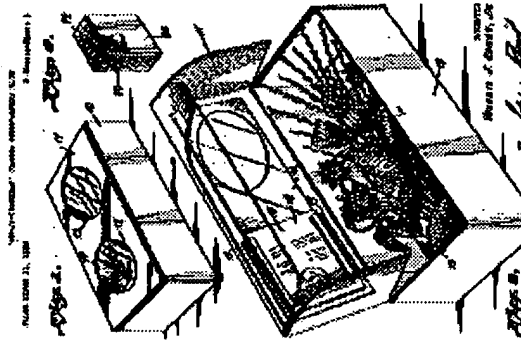
Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 13, 20-25, and 27-34 are rejected under 35 U.S.C. 102(b) as being by Zerbo.

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Zerbo discloses a package (container 10) having an aperture (*window opening 12*); a personalized toy (flowers F, for example, which can be used for amusement or diversion)(*flowers F, for example, which can be used for amusement or diversion*) in the package (container 10); and printed material (18), separate from the toy (*flowers F, for example, which can be used for amusement or diversion*) and further including customer-defined identifying material (*printed matter which is directed to configuration of the toy desired by the person that has the package*), supported on the package (container 10) so that the identifying material (*printed matter which is directed to configuration of the toy desired by the person that has the package*) is visible through the aperture (*window opening 12*) of the package (container 10) and where the identifying material includes a customer-defined intended recipient (*the intended recipient being the person or purchases or receives the package in the particular desired configuration*); a flap (cover 11), separate from the toy (*flowers F, for example, which can be used for amusement or diversion*) and having an inside and an outside, where the inside of the flap (cover 11) faces the personalized toy; an aperture (*window opening 12*) in the flap (cover 11); and a customer-defined identifying material separate from the flap (cover 11) and supported on the inside of the flap (cover 11),

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wherein the customer-defined identifying material includes a customer-defined intended recipient (*the intended recipient being the person or purchases or receives the package in the particular desired configuration*);; the identifying material includes a customer-defined toy name (col. 3, lines 4-12); a toy-support card to display the personalized toy (*flowers F, for example, which can be used for amusement or diversion*) within the package (container 10), the customer-defined identifying material has a front side and a back side, wherein the front side of the material is visible through the aperture (*window opening 12*) on the outside of the flap (cover 11) and the back side is visible on the inside of the flap (cover 11); the inside of the flap (cover 11) includes tabs (*pocket 15*) configured to support the identifying material (18) on the inside of the flap (cover 11); the flap (cover 11) is adapted to be opened to reveal the personal toy (*flowers F, for example, which can be used for amusement or diversion*); the personalized toy (*flowers F, for example, which can be used for amusement or diversion*) is visible through the aperture (*window opening 12*) when the identifying material (18) is removed; the visible portion of the identifying material (18) blocks the aperture (*window opening 12*) (*see Figure 2*), preventing the viewing of the personalized toy (*flowers F, for example, which can be used for amusement or diversion*) from the exterior of the package (container 10); a toy-support card (16) to display the personalized toy within the package (container 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 13, 20-25, and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zerbo.

Zerbo discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the customer-defined identifying material with an indication of a customer-defined intended recipient, a toy name, or a story since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of instructional or aesthetic indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. customer-defined intended recipient, a toy name, or a story, and the substrate e.g. package insert, which is required for patentability.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

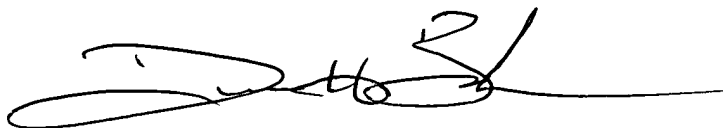
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 571-272-4420. The examiner can normally be reached on Monday through Friday, from 5:45AM - 2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.

Urszula M. Cegielnik
Assistant Examiner
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A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**